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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,915	09/11/2003	Norbert Guntherberg	49756-02	2297
26474	7590	10/29/2004		
KEIL & WEINKAUF 1350 CONNECTICUT AVENUE, N.W. WASHINGTON, DC 20036			EXAMINER MULLIS, JEFFREY C	
			ART UNIT	PAPER NUMBER
			1711	
DATE MAILED: 10/29/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/658,915	Applicant(s) GUNTHERBERG ET AL.	
	Examiner Jeffrey C. Mullis	Art Unit 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 11, 13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 11, 13 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>903</u> . | 6) <input type="checkbox"/> Other: _____ |

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Applicants have not complied with the requirements for claiming benefit of priority for Serial No. 09/913,184 and International Application PCT/EP00/00962 in that no reference to International Application PCT/EP00/00962 has been made in the application as required by 37 CFR 1.78.

The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ 2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-7, 11, 13 and 14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 6,649,117.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the concept of the claimed compositions would have been obvious given that the patent claims use the claimed composition; it was also known at the time of the invention to mix components in an apparatus to

obtain compositions and therefore to mix the components recited by means of an apparatus would have been obvious to a practitioner at the time of the invention in order to obtain the composition; with regard to the method of extruding recited by the application claims, such a method is encompassed by the patent claims.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, 11, 13 and 14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Niessner et al. (CA 2145134) in view of Barghoorn et al. (WO 99/50348) or Hambrecht et al. (USP 4,291,134).

Niessner et al. disclose a composition containing a core-shell graft copolymer as in applicants' core-shell graft copolymer and including an alphaolefin/polar copolymer "B" as in applicants' component B. Note page 7 line 40 - page 10 line 25. A propylene oxide/ethylene oxide copolymer may be added at page

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11 lines 1-4.

The primary reference does not disclose any specific ethylene oxide/propylene oxide block copolymers and in particular does not disclose any triblock ethylene oxide propylene oxide block copolymers with applicants' specific molecular weights.

Hambrecht et al. '134 discloses applicants' specific triblock copolymers. Note the Abstract and column 5 lines 55-65 and column 6 lines 5-48 which disclose that the triblock copolymers of applicants' specific structure and molecular weight confer an antistatic effect and lubricating effect to facilitate processing.

It would have been obvious to a practitioner having ordinary skill in the art at the time of the invention to add the triblock ethylene oxide/propylene oxide block copolymers of the secondary references to the composition of the primary reference to confer antistatic effect and to facilitate processing since the secondary references disclose such a benefit and motivated to extend such a benefit to the primary reference absent any showing of surprising or unexpected results.

With regard to Barghoorn et al., applicants have not submitted a certified translation of applicants' priority documents, MPEP § 201.15 and furthermore applicants have not made a proper claim for priority. Furthermore the German Application

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19906066.5, filed 2-12-1999 was filed more than one year from the filing date of 09/913,184 and therefore nor priority can be claimed to said German application given that applicants have not made a proper claim for priority to 371 Application PCT/EP00/00962, filed 2-7-2000.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Mullis whose telephone number is (571) 272-1075. The examiner can normally be reached on Monday-Friday from 9:30 to 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on (571) 272-1078. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-0994.

J. Mullis:cdc

October 28, 2004

Jeffrey Mullis
Primary Examiner
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A handwritten signature in black ink, appearing to be 'JM', is written over the printed name and title of the examiner.